

REMARKS

This Amendment is submitted simultaneously with filing of the Request for Continuing Examination.

In the Final Action the Examiner rejected the claims under 35 USC 102(e) over the U.S. patent to Shimma, et al.

After carefully considering the Examiners grounds for rejection of the claims over the art, applicants amended Claims 5 and 11, the broadest claims on file, and added Claim 12, which is another independent claim, so as to more clearly define the present invention and to distinguish it from the prior art.

Claim 5, the broadest claim on file, defines a battery pack which comprises the following elements:

a housing (1);

a plurality of battery cells (2) located in an interior of the housing (1) and having longitudinal access,

heat diffusing means for diffusing heat from the battery cells (2),

the heat diffusing means include a wall of the housing which is peripherally adjacent to the battery cells (2) from outside of the battery cells,

the wall of the housing of the heat diffusing means is shaped so that it forms at least one peripherally closed and uninterrupted duct (3, 4),

the duct extends parallel to the longitudinal axis of the battery cells (2) from one axial side to another axial side of the housing (1),

the duct (3, 4) is closed off in its entirety from the interior of the housing (1) in which the battery cells (2) are located,

the duct is configured for passing of a heat diffusing medium from one axial side to another axial side of the housing (1) and between the battery cells (2).

Claim 11 substantially corresponds to Claim 5, but additionally defines that the duct (3, 4) is located between a plurality of individual ones of the battery cells (2).

Turning now to the reference applied by the Examiner, and in particular in the patent to Shimma, this reference does not disclose the heat diffusing means which is formed by a duct having a peripherally closed and uninterrupted wall extending from one axial side to another axial side of the housing and closed off in its entirety from the interior of the housing which accommodates the battery cells, so that the heat diffusing medium passes from one axial side to another axial side of the housing being completely sealed from the interior of the housing in which the battery cells are accommodated.

These features are defined in Claims 5 and 11 and they provide for the highly advantageous results in that, due to the fact that the heat-diffusing medium is not carried at any time through the interior of the battery pack housing which accommodates the battery cells, dirt is prevented from getting into the interior of the battery pack and cannot impair its electrical functions, the duct which is partitioned off from the interior of the battery pack forms only a very slight flow resistance to the heat-diffusing medium flooding through, and results in a strong cooling action.

The original claims were rejected over the patent to Shimma under 35 USC 102(e). In connection with this it is believed to be advisable to cite the decision In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Shimma does not disclose each and every feature of the present invention, as now defined in amended Claims 5 and 11.

Also, as explained hereinabove, the present invention provides for the highly advantageous results which cannot be accomplished by the device disclosed in the patent to Shimma. It is well known that in order to support a

valid rejection in the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the original skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and Amendments, it is believed that Claims 5 and 11 should be considered as patentably distinguishing over the art and should be allowed. Claim 12 should be considered also as patentably distinguishing over the art.

As for the dependent claims, these claims depend on Claim 5, they share its allowable features, and therefore they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is

respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long horizontal flourish extending to the right.

Michael J. Striker
Attorney for Applicants
Reg. No. 27233